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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/698,205
Filing Date: October 31, 2003
Appellant(s): HUMBLES, FRANK FORREST

MAILED
SEP 11 2007
GROUP 3600

Michael E. Mauney
For Appellant

EXAMINER'S ANSWER

The Examiner's Answer mailed 11/24/2006 is hereby vacated and replaced with this updated Examiner's Answer. The previous Answer did not include a "Related Proceeding(s) Appendix" which is now provided.

This is in response to the appeal brief filed 14 August 2006 appealing from the Office action mailed 08 December 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,245,293	OGBURN	06/1941
3,884,225	WITTER	05/1975
4,662,366	TARI	05/1987

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 through 6 and 10 through 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "easily" in claim 2 is a relative term that renders the claim indefinite. The term "easily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claim 3 is similarly rejected for the recitation of "easily and quickly." Claim 10 is similarly rejected for the recitation of "quickly."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 through 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogburn (U.S. Patent No. 2,245,293) in view of Witter (U.S. Patent No. 3,884,225) and Tari (U.S. Patent No. 4,662,366).

Ogburn '293, as seen in Figures 1, 2 and 5, shows an arm protection apparatus for positioning a patient's arms (11) when in a prone or supine position on a patient support comprising:

with regard to claim 1,

(a) at least one member with a central portion (11) positionable under the patient's body;
(b) on said at least one member, a soft cushion pad right arm section (19) positionable around the right arm of a patient including means for attaching (33, 34 and 35, collectively) said soft cushion pad right arm section to said central portion of said at least one member so that said soft cushion pad right arm section is folded around a patient's right arm; and

(c) on said at least one member, a soft cushion pad left arm section (19) positionable around the left arm of a patient including means for attaching (33, 34 and 35, collectively) said soft cushion pad left arm section to said central portion of said at least one member so that said soft cushion pad left arm section is folded around a patient's left arm;

with regard to claim 2,

wherein said member is made of material that is easily cut whereby a portion of the member may be cut away when necessary for visualizing a portion of a patient's body that may be otherwise covered by said at least one member; and

with regard to claim 3,

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wherein said right and left means for attaching readily attach and detach whereby said right and left arm sections may be easily and quickly attached and detached from said central portion of said at least one member.

Ogburn '293 fails to teach:

the at least one member being a soft cushion pad;

the right and left arm sections comprising upper and lower sections foldable around upper and lower parts of a patient's right and left arms;

the at least one soft cushion pad being radiolucent;

the at least one soft cushion pad comprising first and second rectangular sections connected together, thereby forming a generally H-shaped pad with the right arm upper section, left arm upper section, right arm lower section, and left arm lower section comprising legs of the H; and

wherein the H-shaped pad has a width approximately equal to the length of a patient's torso.

Witter '225, as seen in Figure 1, shows a patient turn and hold device comprising a soft radiolucent cushion pad (20) positionable under the patient's body (col. 1, lines 59 through 63; and col. 2, lines 34 through 36).

Tari '366, as seen in Figures 1 through 4, shows an arm support (10) for a patient's arms comprising separate upper and lower assemblies (30 and 32) positionable about the upper and

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lower sections (18 and 22) of an arm of a patient (14), the upper and lower assemblies configured to immobilize the entire arm of a patient (col. 3, lines 62 through 67), wherein each of the upper and lower sections includes means for attaching (45 and 46).

With regard to claim 1, it would have been obvious to one having ordinary skill in the art of supports at the time the invention was made to modify the central member of the device shown by Ogburn '293 such that it would include a soft cushion pad as taught to be desirable by Witter '225. The motivation would have been to enhance the comfort of a patient lying on the apparatus.

With regard to claim 1, it would have been obvious to one having ordinary skill in the art of supports at the time the invention was made to modify the device shown by Ogburn '293 such that the right and left arm sections would each include upper and lower sections as taught by Tari '366. The motivation would have been to provide support for the upper and lower sections of a patient's right and left arms, respectively.

With regard to claim 4, while Ogburn '293 broadly addresses the type of materials suitable for the arm section cushion pads (col. 2, line 4), it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them radiolucent. The motivation would have been to permit radiological operations to be performed on a patient while positioned in the arm protection apparatus.

With regard to claims 5 and 6, a generally H-shaped pad having a width approximately equal to the length of a patient's torso is inherent to the device shown by Ogburn '293 as modified above by Witter '225 and Tari '366.

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5. Claims 7 through 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogburn (U.S. Patent No. 2,245,293) in view of Witter (U.S. Patent No. 3,884,225).

Ogburn '293, as seen in Figures 1, 2 and 5, shows an arm protection apparatus for positioning around a patient's arms when in a prone or supine position on a patient support comprising:

with regard to claim 7,

(a) at least one central member (11), said central member sized to be positioned under the torso of a patient;

(b) attached on said central member, at least one arm section cushion pad (19) with an arm end extending away from said central member, said at least one arm section cushion pad sized to loop around at least a portion of an arm of a patient; and

(c) means for attaching (33, 34 and 35, collectively) said arm end of said at least one arm section cushion pad to said central member, whereby at least a portion of an arm of a patient may be contained within said at least one arm section cushion pad looped around an arm of a patient and held into place in proximity to a patient's torso;

with regard to claim 8,

wherein said central member is sized whereby there is a plurality of arm sections;

with regard to claim 10,

wherein said means for attaching readily attach and detach whereby said plurality of arm sections may be quickly used to secure a patient's arm or to unsecure a patient's arm in proximity to a patient's torso;

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with regard to claim 11,

wherein said plurality of arm sections are constructed of material that is easily cut whereby a portion of said plurality of arm sections may be cut away when necessary for visualizing a patient's arm folded within said arm section; and

with regard to claim 12,

wherein there are two arm sections and each arm section is sized to fit around approximately one-half of a patient's arm.

Ogburn '293 fails to teach:

the central member being a cushion pad; and

the plurality of arm section cushion pads being radiolucent.

Witter '225, as seen in Figure 1, shows a patient turn and hold device comprising a soft cushion pad (20) sized to be positioned under the torso of a patient (col. 2, lines 34 through 36).

With regard to claim 7, it would have been obvious to one having ordinary skill in the art of supports at the time the invention was made to modify the central member of the device shown by Ogburn '293 such that it would include a cushion pad as taught to be desirable by Witter '225. The motivation would have been to enhance the comfort of a patient.

With regard to claim 9, while Ogburn broadly addresses the type of materials suitable for the arm section cushion pads (col. 2, line 4), it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them radiolucent. The motivation

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would have been to permit radiological operations to be performed on a patient while positioned in the arm protection apparatus.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogburn (U.S. Patent No. 2,245,293) in view of Witter (U.S. Patent No. 3,884,225) as applied to claim 11 above, and further in view of Tari (U.S. Patent No. 4,662,366).

Ogburn '293 as modified by Witter '225 fails to teach:
four arm sections attached to the central cushion pad.

Tari '366, as seen in Figures 1 through 4, shows an arm support (10) for a patient's arms comprising separate upper and lower assemblies (30 and 32) positionable about the upper and lower sections (18 and 22) of an arm of a patient (14), the upper and lower assemblies configured to immobilize the entire arm of a patient (col. 3, lines 62 through 67), wherein each of the upper and lower sections includes means for attaching (45 and 46).

With regard to claim 12, it would have been obvious to one having ordinary skill in the art of supports at the time the invention was made to modify the device shown by the combination of Ogburn '293 and Witter '225 such that it would include four arm sections as taught by Tari '366. The motivation would have been to provide support for the upper and lower sections of a patient's right and left arms.

(10) Response to Argument

In response to Appellant's arguments regarding claim 1, as generally set out in In Re Schreiber, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997), during examination, statements in a claim reciting the purpose or intended use of the claimed invention must be evaluated to determine whether such recited purpose or intended use results in a structural difference between the claimed invention and the prior art applied by the Examiner. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if the prior art restraining device in Ogburn '293 is capable of performing the function or intended use of protecting a person's arm as recited in the claims, then it meets the claim. Moreover, the Examiner contends that anything that covers the arm inherently protects the arm.

In response to Appellant's arguments regarding claims 2 and 11, the Examiner contends that the invention as claimed fails to distinguish from the prior art soft cushion pad material taught by the combination of Ogburn '293 and Witter '225 (see Ogburn '293 in col. 2 at lines 3 through 6) when the claims are interpreted as broadly as its terms reasonably allow as required in In re Zletz, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). The Examiner further contends that shears are standard tools for a medical facility and could "easily" cut the prior art material.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As was made clear in *In re Schreiber*, at 129 F.3d at 1473, 44 USPQ2d at 1429, by choosing to define an element functionally as in Claims 3 and 10 on appeal, Appellant assumes a risk, that risk being that where the Patent and Trademark Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the Applicant to prove that the subject matter shown in the prior art does not possess the characteristic relied upon. In the present case, Appellant has provided no evidence to prove that the means for attaching taught by the combination of Ogburn '293 and Witter '225 do not readily attach and detach as recited in the claims.

In response to Appellant's statement regarding Claims 3 and 4 that Witter '225 does not suggest the pad (20) to be radiolucent, the Examiner contends that fleece pads (col. 2, line 9) are inherently radiolucent.

In response to Appellant's assertion that the Examiner "cherry picks" when combining Ogburn '293, Witter '225 and Tari '366, the Examiner contends the proper test for obviousness under 35 USC §103 is what the combination of reference teachings taken collectively would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972) and *In re Laskowski*, supra. Thus, when it is necessary to select elements of various teachings in order to arrive at the claimed invention, it is necessary to ascertain whether there is any suggestion or motivation in

the prior art to make the selection made by applicant. See Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

The Examiner further notes Appellant's repeated use of the term "hard" when referring to the apparatus disclosed by Ogburn '293. The Examiner is unclear how Appellant concludes that the arm sections (19) of the prior art are "hard" when this term does not appear anywhere in the disclosure, and the cuffs (16 and 17) upon which the arms sections are disposed are shown in a rolled position in Figure 1. It is the Examiner's position that Appellant has mischaracterized the prior art.

In response to Appellant's traversal of the rejection of claims 2 through 6 and 10 through 12 under 35 USC §112, second paragraph, the Examiner notes that the purpose of the second paragraph of Section 112 is to allow the boundaries of protection of a patent to be readily and accurately determined by those who would approach the area circumscribed by the claims. See *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). With specific regard to Appellant's arguments regarding the Examiner's holding of the term "easily" as relative terminology, the Examiner contends that Appellant attempts to serve as his own judge to arrive at his own self-serving conclusion of what the terms "easily" and "quickly" mean. Moreover, the Examiner notes that Appellant seems to be relying on the Specification to impart to the claims limitations otherwise not present therein with his characterization of the claimed invention as a "surgical arm positioning pad."

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



TARA L MAYO
PATENT EXAMINER

Conferees:

Thomas B. Will 

Daniel Stodola 